

Philip Tucker confirmed that the first restriction requirement in this case is now withdrawn in favor of the 2nd Restriction Requirement, and thus Applicants' earlier response to the first restriction requirement is now deemed moot.

2. Claims 1-40 are pending in the application. All 40 claims are designated by the Examiner as subject to the 2nd Restriction Requirement.

3. The Examiner also states at the bottom of page 3 of the 2nd Restriction Requirement that claims 1-40 are generic. Applicants thus do not understand why the Examiner is currently designating all 40 pending claims as subject to a restriction requirement. Applicants request clarification by the Examiner.

4. Applicants accept, without traverse, the restriction requirement of inventions I and II as set forth on page 2 of the 2nd Restriction Requirement. Applicants elect *invention I* for further prosecution on the merits in this application.

5. Applicants traverse the Examiner's designation of invention III as subject to a separate restriction requirement, as also set forth on page 2 of the 2nd Restriction Requirement. Applicants urge that pending claim 26 should be allocated to invention II, and pending claims 33 and 40 should be allocated to invention I.

6. Applicants traverse the Examiner's designation of invention III as subject to a separate restriction requirement for several reasons:

- a. The Examiner states on page 2 of the 2nd Restriction Requirement that "[i]nventions II and III are related as mutually exclusive species in an intermediate-final product relationship." Applicants respectfully submit that this cannot be the case.

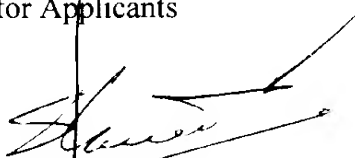
- i. The Examiner states on page 3 that claims 1-40 are generic. Applicants cannot understand how claims 26, 33 and 40 in invention III can at the same time be generic and also "mutually exclusive species in an intermediate-final product relationship."
  - ii. Claim 26, designated by the Examiner to be included in invention III, is dependent on claim 12. Both claims 12 and 26 recite the same guar gum product, except that in claim 26 the product is further recited as an agent in one of a series of host products set forth in Markush form. Since claims 12 and 26 recite the same guar gum product in differing levels of detail, it cannot be correct that they recite "mutually exclusive species in an intermediate-final product relationship," as alleged by the Examiner.
  - iii. The Examiner has also designated claims 33 and 40 to be included in invention III. Claims 33 and 40 recite a method and an improvement on a method respectively. Claim 33 depends on claim 27, which recites a method, and claim 40 depends on claim 34, which recites an improved method. In contrast, the claims of invention II recite a product. Applicants cannot understand how a method and/or an improvement on a method, as recited in claims 33 and 40 under invention III, can be related to the product recited in the claims of invention II as "mutually exclusive species in an intermediate-final product relationship." Claims 33 and 40 are directed to a different type of statutory subject matter from the claims of invention II.
- b. The Examiner states on page 2 of the 2nd Restriction Requirement that "[i]nventions II and III are related as mutually exclusive species in an intermediate-final product relationship. .... In the instant case, the intermediate product is deemed to be useful as a thickener in subterranean operations other than drilling or fracturing, and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants." It is clear from these statements that the

Examiner has used his own personal knowledge in distinguishing between inventions II and III. **Should the Examiner not withdraw the identification and designation of invention III in response to this paper, therefore, Applicants respectfully request and require that, pursuant to Rule 104(d)(2), the Examiner submit and make of record an affidavit in which the Examiner sets forth his data as specifically as possible in support of his personal knowledge used to distinguish inventions II and III.**

7. In view of Applicants' traversal above, the Examiner is respectfully requested to withdraw his designation of invention III. The Examiner is further requested to allocate claims 33 and 40 to invention I (elected above for further prosecution on the merits), and to allocate claim 26 to invention II (not elected).

Respectfully submitted,

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